REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-26 remain pending in the case. The Examiner is thanked for performing a thorough search.

REQUEST FOR ENGLISH TRANSLATION OF CITED JAPANESE PATENT REFERENCE

For the fourth time during the prosecution of the current patent application, Applicants respectfully request an English translation of the cited non-English reference, Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference.

Applicants respectfully point out that the only text in support of the rejection based in part on Mihata is based solely on the Abstract of Mihata, which is the only portion of Mihata translated into English. Applicants respectfully assert that the Manual of Patent Examining Procedure (MPEP) requires that "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that it is clear as to the precise facts the examiner is relying on in support of the rejection" (MPEP 706.02 II., emphasis added). "Citations of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. ... It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." Ex parte Jones, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001). "In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings ...." Ex parte Jones, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001); MPEP 706.02 (emphasis added).

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the

Examiner provide a complete translation of Mihata in order to fully understand its teachings.

35 U.S.C. §103(a)

CLAIMS 1-3, 5-15 and 17-26

Claims 1-3, 5-15 and 17-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,059,842 by Dumarot et al., (hereinafter referred to as "Dumarot") in view of United States Patent 6,144,954 by Li, (hereinafter referred to as "Li"). Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 1-3, 5-15 and 17-26 are neither taught nor suggested by Dumarot or Li, alone or in combination.

Independent Claim 1 recites,

> A computer-implemented method for enhancing performance of a computer system, comprising:
> electronically deriving relationships over time between monitored system variables and monitored performance of said computer system;
> automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and
> adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system.

Applicants respectfully assert that Dumarot does not teach or suggest, "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1.

The Office Action asserts that Dumarot teaches "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1 at 330, 341, 351, Col. 7 lines 25-35, Col. 7 lines 5-16, Col. 7 lines 10-16, and Col. 5 lines 10-17. However, all of these cited portions of Dumarot refer to "rules" not "relationships." Further, even assuming for the sake of argument that Dumarot's "rules" are analogous to Claim 1's "relationships" note that Dumarot's "rules" appear to be either preconfigured hard coded values as indicated, among other places, by Col. 7 lines 25-35 of Dumarot or specified by a "company or system administrator" as indicated by Col. 8 lines 16-18. Then a user can select a rule as indicated in many portions of Dumarot such as the abstract, Col. 3

lines 21-22, Col. 3 lines 43-46, Col. 4 lines 49-50, Col. 7 lines 39-43, and Co. 8 lines 26-33.

Therefore, even assuming for the sake of argument that Dumarot's "rules" are analogous to Claim 1's "relationships," Dumarot still does not teach or suggest "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system." Further, by teaching a system that utilizes and requires a user to select preconfigured hard coded rules, Dumarot teaches away from "electronically deriving relationships over time," (emphasis added).

The Office Action asserts that Dumarot teaches "electronically deriving relationships over time," (emphasis added) at Col. 7 lines 10-16 and Col. 5 lines 10-17. However, Dumarot teaches at Col. 7 lines 10-16 "determining changes to system and application configurations at different points in time." This is not "electronically deriving relationships over time," (emphasis added). Col. 5 lines 10-17 refer to "dynamic data." It appears to Applicants that the Office Action is asserting that Dumarot's "dynamic data" is analogous to Claim 1's "relationships" which are electronically derived over time. However, Dumarot states in Col. 4 lines 7-10, "The dynamic data is generally dynamic information, such as current CPU, memory, and disk use, all of which change as an application performs operations, and reads and writes information to memory and disk." Therefore, Col. 5 lines 7-10 make it clear that Dumarot's "dynamic data" does not teach or suggest anything about "relationships" let alone teach or suggest "electronically deriving relationships over time." Further, the Office Action mailed September 25, 2006 did not rebuttal Applicants' arguments made in the reply mailed June 21, 2006 with regards to Dumarot not teaching or suggesting "electronically deriving relationships over time..." Applicants respectfully request a response to Applicants' arguments regarding "electronically deriving relationships over time..."

For the foregoing reasons, Claim 1 should be patentable over Dumarot for at least the reason that Dumarot does not teach or suggest "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1. Refer to the reply mailed June 21, 2006 for reasons that Dumarot does not teach or suggest several other limitations recited by Claim 1.

Li does not remedy the deficiency in Dumarot in that neither Dumarot nor Li teach or suggest "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1. In fact, the Office Action does not even assert that Li teaches "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system." Further, Li cannot be combined with Dumarot to teach "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system" because Li teaches away from "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system." For example at Col. 4 lines 53-58 Li states,

> setting the m variables to the thus-computed optimal combinations before these combinations change; and feeding back information on the status of optimization to achieve closed-loop feed-back control. The knowledge bases so generated are instantly machine-coded. (emphasis added)

Since Li teaches feeding the "combinations" before they change and instantly machine coding based on those combinations, Li teaches away from "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1.

Col. 19 lines 58-65 is another example of Li teaching away from "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system." At Col. 19 lines 58-65, Li states,

> Again for the self-optimizing machine, the software optimizing task such as for software generation, usage or maintenance, computer simulation, and computer aided design (CAD), engineering (CAE), or testing (CAT) etc. is first defined. The optimizing criteria of the usual cost, productivity, and quality, in different weighing indices are next given. The number, type, and allowable range of the variables in different categories are then fed. (emphasis added)

Therefore, Claim 1 should be patentable over Dumarot and Li for at least the reason that both Dumarot and Li teach away from "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," as recited by Claim 1. Independent Claims 12, 14, and 24 should be patentable for similar reasons that Claim 1 should be patentable. Claims 2, 3 and 5-11 depend from independent Claim 1, Claim 13 depends from independent Claim 12, Claims 15 and 17-23 depend from independent Claim 14, and Claims 25 and 26

depend from independent Claim 24. The dependent claims include all of the limitations of their respective independent claims. Further the dependent claims include additional limitations which further make them patentable. Therefore, the dependent claims should be patentable for at least the reasons that the respective independent claims should be patentable.

35 U.S.C. §103(a)

Claims 4 and 16

Claims 4 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view of Li, further in view of the English Abstract of Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference. Claim 4 depends from independent Claim 1 and Claim 16 depends from independent Claim 14. Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 4 and 16 are patentable over the combination of Dumarot in view of Li, further in view of Mihata.

As described above in the discussion of the rejection of Claims 1-3, 5-15 and 17-26, the combination of Dumarot in view of Li teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1 and 14. Moreover, the combination of Dumarot in view of Li, further in view of Mihata fails to teach or suggest the claimed embodiments because Mihata does not overcome the shortcomings of Dumarot in view of Li. Applicants understand Mihata to teach a design rules verifying system. Mihata, alone or in combination with Dumarot and Li, does not show or suggest a method for enhancing performance of a computer system, including "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system," or "automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction," as claimed.

Applicants respectfully assert that nowhere does the combination of Dumarot in view of Li, further in view of Mihata, disclose or suggest the present invention as recited in independent Claims 1 and 14, and that Claims 1 and 14 are thus in condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot in view of Li, further in view of Mihata also does not teach or suggest the additional claimed features of the present invention as recited in Claim 4 that is dependent on

allowable base Claim 1 and Claim 16 that is dependent on allowable base Claim 14. Applicants respectfully submit that Claims 4 and 16 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

Applicants respectfully point out that the rejections based only on Mihata are based only on the Abstract of Mihata, which is the only portion of Mihata that is translated into English. "Citations of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. ... It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." Ex parte Jones, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001). "In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner's rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings .... Ex parte Jones, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001); MPEP 706.02.

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO L.L.P.

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John P. Wagner Jr.
Registration No. 35,398

Address: Westridge Business Park
123 Westridge Drive
Watsonville, California 95076 USA

Telephone: (408) 938-9060 Voice
(408) 234-3749 Direct/Cell
(408) 763-2895 Facsimile